

JP920000070US1

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- 1 -

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Isamu Tobita	:	Chau, Minh H.
Serial No.: 09/886,200	:	Group Art Unit: 2854
Filed: June 21, 2001	:	
Title: PRINTER, FORM PRINTER,	:	Intellectual Property Law
PRINTER CONTROL METHOD AND	:	IBM Corporation 972/B656
PRINT CONTROLLER	:	P.O. Box 12195
	:	Research Triangle Park, NC 27709

September 21, 2005

REQUEST FOR RECONSIDERATION

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Dear Sir:

This Request for Reconsideration is being submitted in response to the Board's Decision for Application No. 09/886,200 (Appeal No. 2005-1384) with a mailing date of August 23, 2005.

CERTIFICATION UNDER 37 C.F.R. 51.8

I hereby certify that this correspondence is being faxed to 571-273-0299, the Clerk of the Board, Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 21, 2005.


Signature

Toni Stanley
(Printed name of person certifying)

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REQUEST FOR RECONSIDERATION

This is a request to Administrative Patent Judges Thomas, Saadat and Nappi to reconsider their ruling sustaining the Examiner's final rejection of claims 1-13 for the above-indicated case. Appellant believes that if the Administrative Patent Judges reconsider Appellant's arguments that the Administrative Patent Judges would render a different ruling. Appellant kindly requests the Administrative Patent Judges to review the material below which highlights the main reasons why Appellant believes that a reconsideration of the ruling is justified.

A. Appellant was not arguing limitations not disclosed with respect to claims 10, 11, 12 and 13.

Appellant argued that Kikuchi and Ohsawa, taken singly or in combination, do not teach or suggest "identifying a character set to be printed" as recited in claim 10. Supplemental Appeal Brief, page 10. Appellant specifically stated that there is no language in the passages cited by the Examiner that teaches identifying a character set where a character set may refer to a particular setting, font, etc. of characters (images) to be printed. Supplemental Appeal Brief, page 10. This definition of a character set comes straight from the Specification (page 8, line 17). The Board asserted that Appellant was incorporating limitations not claimed. Board's Decision, page 5. The Board is mistaken as Appellant was not incorporating limitations not claimed but instead was using the definition of character set specifically defined in the Specification. The Specification can be used in interpreting claim language when it provides definitions for terms appearing in the claims. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 U.S.P.Q.2d 1065, 1069 (Fed. Cir. 1999); *In re Vogel*, 422 F.2d 438, 441, 164 U.S.P.Q. 619, 622 (C.C.P.A. 1970). Otherwise, Appellant's right in being its own lexicographer would be defeated. See M.P.E.P. §2111.01. Hence, Appellant respectfully requests the Board to reconsider the rejection to claim 10 and similarly to claims 11-13 in light of the above.

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B. Kikuchi and Kobayashi, taken singly or in combination, do not teach or suggest the limitation of claims 8 and 9.

Appellant argues that Kikuchi and Kobayashi, taken singly or in combination, do not teach or suggest the limitations of claims 8 and 9. Supplemental Appeal Brief, pages 16-17. The Board states that:

The examiner properly relies upon Kobayashi as advantageous modifying reference such It teaches the ability to control the pulse width for given print heads again in a dot-matrix type printer in accordance with the total number of dots used to print the character or an image or the total number of dots that are arranged across the width or line forming a print image to the extent claimed. The examiner correctly makes note to the dot counter and element 14 in Figure 3. Additionally, we make reference to the complete teachings shown in Figures 3-5 of Kobayashi. By counting the number of dots to be printed forming a given character, Kobayashi additionally teaches the ability to control the width of the current pulse to effectively informally control the print thickness. Since both references desire to perform a wide variety of printing operations with constant quality, the artisan clearly would have found it obvious to have utilized the teachings of Kobayashi to modify those of Kikuchi. Board's Decision, pages 12-13.

The Board never addressed the limitations of claims 8 and 9. Claim 8 recites "wherein the impact force is set to a mode at one of a plurality of levels, and the impact force controller changes the mode in accordance with the number of dots that are arranged across the widths of lines forming an object image." The Board has not addressed setting the impact force to a mode at a level. Neither has the Board addressed the concept of a mode or changing a mode. Similarly, claim 9 recites "wherein, the command for changing the mode is included in print data for a character, and the impact force controller changes the mode in response to said mode." Again, the Board has not addressed a command for changing a mode. Neither has the Board addressed a command for changing a mode that is included in print data for a character. Neither has the Board addressed an impact force controller changing a mode. Hence, Appellant respectfully requests the Board to reconsider the rejection to claims 8 and 9 in light of the above.

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C. Combining Kikuchi with Ohsawa would change the principle of operation of Kikuchi.

Appellant has argued that by combining Kikuchi with Ohsawa that the principle of operation of Kikuchi would change. Supplemental Appeal Brief, pages 8-10. The Board asserted that Appellant was arguing structural combinability and that such an argument was improper. Board's Decision, page 7. However, as understood by Appellant, *In re Ratti* stands for the proposition that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The court concluded that combination of references would require a substantial reconstruction and redesign of the element shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.) Based on Appellant's reading of *In re Ratti*, it is important to look at the structure combination of the prior art references such as to see if there is a substantial reconstruction or redesign. The Board states that the teachings themselves are what are to be considered. Board's Decision, page 7. However, the teachings are what describe the structure and the teachings are relied upon by Appellant in their arguments. Appellant has cited the relevant sections in the teachings of Kikuchi and Ohsawa to support its arguments.

It also is important that the entire reference be considered in its entirety, i.e., as a whole, and not just a portion of the reference. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Hence, it appears that one cannot just look at particular sections of a reference without taking into consideration what the entire reference teaches including those portions that would lead away from the claimed invention. Hence, Appellant respectfully requests the Board to reconsider the rejection to claims 2-6 and 10-13 in light of the

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above. If the Board maintains the belief that such an argument is improper, then Appellant respectfully requests the Board to clarify their rationale.

D. Examiner has not presented a reasonable expectation of success in combining Kikuchi with the IBM Disclosure Bulletin.

Appellant has argued that the Examiner has not presented a reasonable expectation of success in combining Kikuchi with the IBM Disclosure Bulletin. Supplemental Appeal Brief, pages 15-16. Appellant has emphasized that the IBM Disclosure Bulletin teaches a typewriter while Kikuchi teaches a dot matrix printer. Supplemental Appeal Brief, pages 15-16. The Board states that Appellant is arguing against structural combinability and that such an argument is improper. Board's Decision, page 11. Appellant fails to understand why such an argument is improper. If for example, one reference teaches a boat and another references teaches a computer, then it would seem fair to request to the Examiner to present a reasonable expectation of success in combining these references as required to establish a *prima facie* case of obviousness. M.P.E.P. §2143. Further, the Examiner in responding to Appellant's request for the Examiner to present a reasonable expectation of success in combining Kikuchi with the IBM Disclosure Bulletin ignored the entire teachings of the IBM Disclosure Bulletin. Reply Brief, pages 6-7. The Examiner must consider the prior art reference in its entirety. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); M.P.E.P. §2141.02. Hence, Appellant respectfully requests the Board to reconsider the rejection to claims 5 and 12-13 in light of the above. If the Board maintains the belief that such an argument is improper, then Appellant respectfully requests the Board to clarify their rationale.

E. Examiner has not identified any source of motivation.

The Examiner's motivation for modifying Kikuchi with Ohsawa to include the missing limitation in claims 2, 4, 6, 10 and 11 is "so that the design density for a selected character can be achieved." Examiner's Answer, pages 5 and 6. The Examiner's motivation for modifying Kikuchi and Ohsawa with the IBM Disclosure Bulletin to

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include the missing limitation in claim 5 is "so that the impact force of the selected character can be precisely achieved." Examiner's Answer, page 7. The Examiner's motivation for modifying Kikuchi and Ohsawa with the IBM Disclosure Bulletin to include the missing limitation in claims 12 and 13 is "so that the print quality of a variety of character font can be achieved." Examiner's Answer, page 9. The Examiner's motivation for modifying Kikuchi with Kobayashi to include the missing limitations of claims 7 and 8 is "so that the thickness or the print density of a selected character or image can be consistency maintained." Examiner's Answer, page 8.

In order to establish a *prima facie* case of obviousness, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in come cases the nature of the problem to be solved, to modify the reference or to combine reference teachings. See *In re Dembiczak*, 173 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the Examiner has not provided any evidence that these motivations come from any of these sources. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Hence, Appellant respectfully requests the Board to reconsider the rejection to claims 2-6 and 10-13 in light of the above.

If the Board is asserting that the Examiner's motivations come from the nature of the problem to be solved, then Appellant notes that it is the burden of the Examiner to indicate such a source in order to support a *prima facie* case of obviousness. M.P.E.P. §2142. The Board of Patent Appeals and Interferences is to affirm or reverse the decision of the Examiner in whole or in part based on the Examiner's arguments. M.P.E.P. §1213. It is Appellant's understanding that the Board is not to rewrite the Examiner's arguments or to provide additional explanation to the Examiner's rejections. Otherwise, Appellant does not have an opportunity to respond or to assess the strength of the Examiner's rejections. Hence, Appellant respectfully requests the Board to reconsider the rejection to claims 2-6 and 10-13 in light of the above.

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Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Appellant

By: 

Robert A. Voigt, Jr.

Reg. No. 47,159

Kelly K. Kordzik

Reg. No. 36,571

P.O. Box 50784
Dallas, Texas 75201
(512) 370-2832

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WINSTEADdirect dial: 512 370 2832
rvoigt@winstead.com**FAX COVER SHEET**

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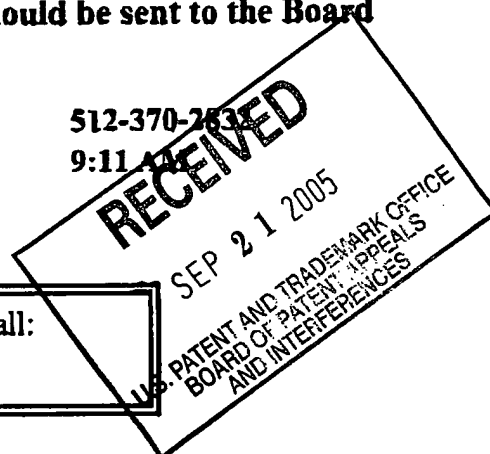
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